

## **Remarks**

### **In the Claims**

Claims 1-18 were pending.

Claims 1-3 are cancelled.

Claim 4 is amended.

Claims 6-8, and 10-18 are original.

Claims 5 and 9 are as previously presented.

Claims 19 and 20 are new.

The application now contains claims 4-20.

Claim 4 is amended to be an independent claim and to incorporate the limitations of now cancelled claim 1 from which it previously depended by replacing the preamble claim 4 with the first few lines of claim1 and adding the description of component (C) at the end of the claim. Support is inherent in claims 1 and 4 as previously presented.

Support for new claims 19 and 20 are found in original claims 2 and 3.

No new matter is added.

Applicants note for the record:

The claims 1-18 under examination are the claims that were under appeal and are the claims as they appeared in the response filed by Applicants on December 9, 2002. In response to the office action dated July 3, 2003, Applicants submitted, in a response dated September 3, 2003, a "clean copy" of the claims as amended in the December 9, 2002 response. In preparing the present response, minor errors in this "clean copy" were discovered, notably, in claim 4, the first full line describing Ar<sub>1</sub>, included the phrase "unsubstituted or". This is obviously an unintentional error as the claims under appeal were presented correctly in accordance with the December 9, 2002 response. In preparing the present response, the correct claims as they appear in the Appeal Brief and response of December 9, 2002 are used.

### **Response to Supplemental Examiner's Answer**

With this response and the amendments herein Applicants request that prosecution be reopened and request that the appeal be withdrawn under 37 CFR 41.50(a)(2)(i).

Claims 1-10 and 12-18 are rejected under 35 U.S. 103 (a) as being unpatentable over Laridon et al. (US 4282309).

Applicants understand from the Supplemental Examiner's Answer that the Examiner has determined that

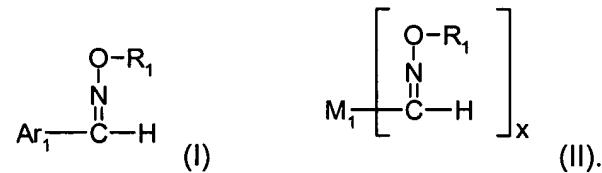
1. the extent of the data showing unobvious results is not commensurate with the breadth of the claims

2. while claim 5 is narrower in scope than claim 1, a judgment on the validity of the claims of unexpected results for the compounds of claim 5 cannot be made as claim 5 requires R<sub>1</sub> be alkanoyl and the data presented in the declaration is for compounds wherein R<sub>1</sub> is benzoyl

3. when R<sub>6</sub> of Laridon is ethoxycarbonyl the limitations of claim 5 that R<sub>1</sub> is C<sub>2-4</sub> alkanoyl are met.

Applicants herein address points 1-3 and respectfully traverse the rejection over Laridon.

In order to further prosecution and more clearly focus on the most important features of the invention, Applicants have deleted claim 1. Claim 4 relates to an alkaline developable, photosensitive composition comprising as component (B) at least one compound of formula I or II



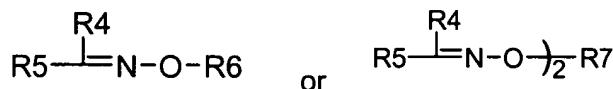
$\text{R}_1$  is  $\text{C}_2\text{-}\text{C}_6$  alkanoyl,  $\text{C}_2\text{-}\text{C}_5$  alkoxy carbonyl, benzoyl or benzoyl substituted by  $\text{C}_1\text{-}\text{C}_6$  alkyl or halogen,

$\text{Ar}_1$  is substituted phenyl or naphthyl, or when  $\text{R}_1$  is acetyl,  $\text{Ar}_1$  can also be unsubstituted or substituted furyl, pyrrolyl, thienyl, benzofuranyl, indolyl, benzothiophenyl or pyridyl.

In canceling claim 1, Applicants remove from present consideration a number of compounds. This should facilitate the arguments presented below, and made previously, that the data of record are sufficient to demonstrate unexpected results commensurate with the scope of the claims.

A distinct feature of the instant invention is the exceptional and previously undisclosed activity of aldoximes relative to ketoximes, i. e., compounds wherein the H of formula I or II is another, larger substituent. The data presented in the Oka declaration found in the appeal brief clearly demonstrates the superiority of aldoximes of the instant invention where  $\text{R}_1$  is benzoyl relative to similar compounds of the closest cited art (Laridon).

Laridon discloses a composition containing a sensitizer a compound of formula



$\text{R}4$  is  $\text{C}_{1-2}$  alkyl, aryl, aralkyl, hydroxy substituted aralkyl, acyl or substituted acyl,

$\text{R}5$  is hydrogen  $\text{C}_{1-2}$  alkyl, aryl, acyl or substituted acyl,

$\text{R}4$  and  $\text{R}5$  may form a ring,

$\text{R}6$  is acyl or substituted acyl and  $\text{R}7$  is diacyl.

- Preferred in Laridon are compounds wherein at least one of R4 or R5 is acyl, particularly benzoyl.

However, Ar1 in the instant invention, corresponding to R4 or R5 of Laridon is never acyl.

- Laridon does not exemplify a compound where R5 is hydrogen.

However, the instant invention relates specifically to the exceptional activity of compounds wherein the R5 position of Laridon is hydrogen.

The Examiner has requested that Applicants provide additional data directly comparing compounds where R<sub>1</sub> is alkanoyl. Applicants respectfully maintain that the data in Tables 2 and 3 found on pages 61-64 of the specification, taken in combination with the data of the declaration make that additional work unnecessary for the following reasons:.

- R<sub>1</sub>, in all of the examples of Tables 2 and 3 is acetyl, that is C<sub>2</sub> alkanoyl.

- The data in Tables 2 and 3 are remarkably similar for all of the inventive compounds either with or without an added sensitizer.

- The data of Tables 2 and 3 is also remarkably similar to the data for compounds B1 and B2 of the Oka declaration.

Applicants respectfully suggest that in light of this data one could reasonably expect that the activity of the compounds currently encompassed by the presently amended claims would be somewhat similar whether R<sub>1</sub> is benzoyl or alkanoyl.

Applicants also respectfully maintain that by showing superiority of these compounds to the closest exemplified art, the burden for showing unexpected results has been met and suggest that points 1 and 2 have been addressed and traversed, as Applicants are obliged to compare compounds from the prior art which are "actually taught" or exemplified, *ex parte Westphal* 223 USPQ 630.

Before addressing point 3 from above Applicants respectfully note that the Examiner maintains that when R<sub>6</sub> of Laridon is ethoxycarbonyl and R5 is hydrogen, the limitations of claim 5 wherein R<sub>1</sub> is C<sub>2-4</sub> alkanoyl are met. Actually ethoxycarbonyl is not encompassed by **alkanoyl** and this assertion does not apply to claim 5. However, ethoxycarbonyl is encompassed in claim 4 where R<sub>1</sub> is C<sub>2-C<sub>5</sub></sub> **alkoxycarbonyl** and so this point is addressed herein as it pertains to claim 4.

Applicants refer to the previous arguments. Laridon does not exemplify compounds where R5 is hydrogen or compounds where R6 is ethoxycarbonyl. Laridon provides a formula (E), column 3, line 40, where R6 is ethoxycarbonyl. The compound of formula (E) contains at R4 and R5 rather large substituents, i.e., phenyl and benzoyl, making such a compound quite different from the aldoximes of the instant invention. Furthermore, Laridon neither prepares nor tests a compound of formula (E) and there is no reason to expect from the disclosure that the compound of formula (E) would be more active than the compound of formula (A).

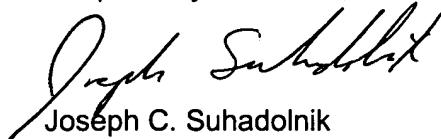
Applicants respectfully assert that in light of the comparisons already of record and the discussion above there is provided no reason for Applicants to prepare and test such a compound as depicted by formula (E) as Applicants are obliged to compare compounds from the prior art, which are "actually taught" or exemplified, *ex parte Westphal* 223 USPQ 630.

Applicants respectfully maintain that they have surprisingly discovered that the aldoxime compounds in the claimed compositions and processes provide enhanced results not made obvious by Laridon or other cited prior art.

Applicants also respectfully maintain that the above discussion and amendments traverse the rejections under 35 U.S.103 (a) over Laridon et al. (US 4282309) and kindly ask that the Examiner withdraw the rejections and find the instant claims 4-20 allowable.

In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



Joseph C. Suhadolnik  
Agent for Applicants  
Reg. No. 56,880  
filed under 37 CFR 1.34(a)

Ciba Specialty Chemicals Corporation  
Patent Department  
540 White Plains Road  
P.O. Box 2005  
Tarrytown, NY 10591-9005  
Tel. (914) 785-2973  
Fax (914) 785-7102